APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,825	12/07/2001	Yasuo Shibusawa	TMI-109	7759

24956 7590 08/08/2007 MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314	EXAMINER WANG, JUE S

ART UNIT	PAPER NUMBER
2193	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/004,825	SHIBUSAWA ET AL.
	Examiner	Art Unit	
	Jue S. Wang	2193	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *22 May 2007*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-8,11 and 16-23* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-8,11 and 16-23* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on *14 May 2002* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☒ All b) ☐ Some * c) ☐ None of:
      1. ☒ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *31 January 2007, 30 July 2007*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-8, 11, 16-23 have been examined.

2.   Claims 9-10 and 12-15 have been cancelled.

Claim Objections

3.   Claim 11 is objected to because of the following informalities:

4.   As per claim 11, the phrase "A for installing software" is used. It is believed that this is a

typographical error of what should read "A method for installing software".

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

6.   Claims 3, 11, 18, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

7.   As per claims 3 and 11, the limitations of "a first database", "a second database",

"accepting means", "first determining means", "second determining means", and "sending

means" are consistent with a system, not a method. As such, it is believed that claims 3 and 11

should be system claims instead of method claims.

        Appropriate corrections are required.

Any claim not specifically addressed, above, is being rejected as incorporating the

deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

9.   Claims 7 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Beelitz et al.

(US 6,247,126 B1, hereinafter Beelitz).

10.   As per claim 7, Beelitz teaches the invention as claimed including a storage medium

having software stored thereon for making a computer system, which has a memory in which

identification information identifying the computer system is stored, execute a function of

installing a specified software onto the computer system (see column 2, line 67 – column 3, line

8, column 4, line 6-22, column 8, lines50-54, and column 10, lines 46-65), wherein,

the software comprises the functions of:

sending the identification information to another computer system (see column 10, lines

46-65; EN: the NetPC identification code must be sent to the manufacturing server in order for

the system descriptor record associated with the identification code to be retrieved from a

database in the manufacturing server);

accepting, following the sending of the identification information, at least one software

component required for operating a hardware component of the computer system sent from the

another computer system (see column 10, lines 38-43, column 10, line 67 – column 11, line 17);

and

conducting setup processing in order to make the accepted at least one software

component into an executable state (see column 11, lines 18-32; EN: the computer must fully

operational (i.e., software are in an executable state) following the completion of the software

installation in order for the NetPC system to be tested).

11.   As per claim 20, Beelitz further teaches that the software component is a device driver

and the hardware component is a peripheral device of the user's computer system (see Fig 1,

items 14, 20, and column 3, lines 52-63).

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

13.   Claims 1-6, 8, 11, 16-19, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Beelitz et al. (US 6,247,126 B1, hereinafter Beelitz), in view of Amberg et al. (US

5,995,757, hereinafter Amberg).

14.   As per claim 1, Beelitz teaches the invention as claimed, including a method for installing

software in a user's computer which is customized according to a user's order and is supplied to a

user under a built-to-order (BTO) scheme (see column 1, lines 6-8, column 1, line 63 - column

2, line 4, column 4, lines 16-22, and column 9, lines 26-32) the method comprising:

         storing identification information of the user's computer system and system configuration

information, associated with the identification information (see column 10, lines 46-65; the

manufacturing server stores NetPC identification code which is associated with a system

descriptor record file);

         storing software components required for operation of the hardware

components of the user's computer system (see column 10, line 37 – column 11, line 4; EN: the

software components are stored on the manufacturing server and downloaded to the NetPC);

         accepting from the user's computer system the identification information of the user's

computer system (see column 10, lines 61-65; EN: the NetPC identification code used to retrieve

the associated SDR file must be from sent from the NetPC since the NetPC is downloading the

software required for its system); and

         sending, to the user's computer system, the software components required for operation

of the hardware components of the user's computer system (see column 10, line 37 – column 11,

lines 17; EN: the device drivers are software required for the operation of the hardware

components).

         Beelitz does not explicitly teach that the system configuration information indicates

hardware component of the user's computer and Beelitz does not specifically teach determining

the software components required for operation of the hardware components of the user's

computer system as indicated in the system configuration information.

Amberg teaches a method for installing and testing software for a build-to-order

computer system where the system configuration information indicates hardware component of

the user's computer (see Fig 3B, item 370 and column 6, lines 33-40) and determining the

software components required for operation of the hardware components of the user's computer

system from the stored system configuration information (see Fig 5, steps 500-550 and column

8, lines 20-36, column 9, lines 31-37, 46-52, and column 10, lines 29-41; EN: the software

installation steps associated with the hardware components in the system descriptor record

indicates the software that needs to be installed for the hardware components of the system).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to have combined Beelitz with Amberg because Amberg further teaches that the system

descriptor record file disclosed in Beelitz (see column 10, lines 46-65 of Beelitz) indicates

hardware components of the user's computer and it is used to determine the software

components required for operation of the hardware components of the user's computer system to

facilitate easier customization of testing and software installation procedures for built-to-order

computer systems (see column 2, line 20-24, and column 3, lines 33-39 of Amberg).

15.   As per claim 2, Beelitz does not explicitly teach managing, for an individual user, a fee

for the software sent to the user's computer system; and collecting the fee from the user.

However, it would have been obvious to one of ordinary skill in the art at the time of the

invention that a fee is charged and collected for sending the software since the software is part of

the order for the built-to-order computer system and the fee for assembling the computer system

according to the order includes the fee for downloading and installing the software.

16.   As per claim 3, Beelitz teaches the invention as claimed, including a method for installing

software in a user's computer which is customized according to a user's order and is supplied to a

user under a built-to-order (BTO) scheme (see column 1, lines 6-8, column 1, line 63 - column

2, line 4, column 4, lines 16-22, and column 9, lines 26-32), the method comprising:

a first database for storing software components required for operation of hardware

components of a computer system (see column 10, line 37 – column 11, line 4);

a second database for storing identification information for identifying a computer system

supplied to a user (see column 10, lines 46-47, 61-65);

accepting means for accepting from the user's computer system the identification

information given to the user's computer system (see column 10, lines 61-65; EN: the NetPC

identification code used to retrieve the associated SDR file must be accepted from the NetPC

since the NetPC is downloading the software required for its system);

first determining means for determining system configuration information which

corresponds to the accepted identification information, with reference to the second database (see

column 10, lines 61-65);

sending means for sending the determined software components to the user's computer

system (see column 10, line 37 – column 11, lines 17; EN: the device drivers are software

required for the operation of the hardware components).

Beelitz also does not explicitly teach that the system configuration information associated with the identification information indicates hardware components of the computer system, and Beelitz does not explicitly teach the second determining means for determining the software components required for operation of the hardware components indicated in the system configuration information, with reference to the first database.

Amberg teaches a method for installing and testing software for a build-to-order computer system where the system configuration information indicates hardware component of the user's computer (see Fig 3B, item 370 and column 6, lines 33-40) and determining the software components required for operation of the hardware components of the user's computer system from the stored system configuration information, with reference to a database (see Fig 5, steps 500-550 and column 8, lines 20-36, 50-57, column 9, lines 31-37, 46-52, and column 10, lines 29-41; EN: the software installation steps associated with the hardware components in the system descriptor record indicates the software that needs to be installed for the hardware components of the system).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined Beelitz with Amberg because Amberg further teaches that the system descriptor record file disclosed in Beelitz (see column 10, lines 46-65 of Beelitz) indicates hardware components of the user's computer and it is used to determine the software components required for operation of the hardware components of the user's computer system to facilitate easier customization of testing and software installation procedures for built-to-order computer systems (see column 2, line 20-24, and column 3, lines 33-39 of Amberg).

17.   As per claim 4, Beelitz teaches the invention as claimed, including a method for installing

software in a user's computer which is customized according to a user's order and is supplied to a

user under a built-to-order (BTO) scheme (see column 1, lines 6-8, column 1, line 63 - column

2, line 4, column 4, lines 16-22, and column 9, lines 26-32), the method comprising the steps of:

        sending identification information identifying a first computer system to a second

computer system (see column 10, lines 46-65);

        accepting, in response to the above step, at least one software component required for

operation of a hardware component of the first computer system (see column 10, line 37 –

column 11, lines 17; EN: the device drivers are software required for the operation of the

hardware components); and

        conducting setup processing in order to make the at least one software component

accepted in the accepting step into an executable state in the first computer (see column 11, lines

18-32).

        Beelitz teaches storing the system configuration information corresponding to the

identification information sent from the first computer in the second computer system (see

column 10, lines 61-65). Beelitz does not teach that the system configuration information

indicates the hardware components for which software components are required.

        Amberg teaches a method for installing and testing software for a build-to-order

computer system where the system configuration information indicates hardware component of

the user's computer (see Fig 3B, item 370 and column 6, lines 33-40) and determining the

software components required for operation of the hardware components of the user's computer

system from the stored system configuration information (see Fig 5, steps 500-550 and column

8, lines 20-36, column 9, lines 31-37, 46-52, and column 10, lines 29-41; EN: the software

installation steps associated with the hardware components in the system descriptor record

indicates the software that needs to be installed for the hardware components of the system).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to have combined Beelitz with Amberg because Amberg further teaches that the system

descriptor record file disclosed in Beelitz (see column 10, lines 46-65 of Beelitz) indicates

hardware components of the user's computer and it is used to determine the software

components required for operation of the hardware components of the user's computer system to

facilitate easier customization of testing and software installation procedures for built-to-order

computer systems (see column 2, line 20-24, and column 3, lines 33-39 of Amberg).

18.   As per claim 5, Beelitz further teaches the first computer system reads and executes a

specified installation software which is stored in a specified storage medium (see column 2, line

67 – column 3, line 8, column 4, line 6-22, the manufacturing code).

19.   As per claim 6, Beelitz further teaches a step of storing the at least one software

component which the first computer system receives from the second computer system (see

column 10, lines 43-45, and column 11, lines 10-17).

20.   As per claim 8, Beelitz teaches the invention as claimed, including an installation system

for a client/server system comprising a first computer system and a second computer system, by

which software is installed onto the first computer system (see column 1, lines 6-8, column 1,

line 63 - column 2, line 4, column 4, lines 16-22, column 9, lines 26-32, and column 10, lines

38-45),

wherein the first computer system (the NetPC, see column 10, lines 40-41) comprises:

means for storing identification information for identifying the first computer system (see

column 1, line 63 - column 2, line 4 and column 10, lines 46-65);

means for connecting the first computer system to the second computer system and for

sending the identification information to the second computer system, in accordance with

recovery instructions (see column 2, lines 61-62, column 5, line 51 – column 6, line 5, and

column 9, lines 55-65); and

first accepting means for accepting at least one software component sent from the second

computer system (see column 10, line 37 – column 11, lines 17), and

wherein the second computer system (the manufacturing server, see column 10, lines 40-

41):

a first database for storing software components required for operation of hardware

components of the first computer system (see column 10, line 37 – column 11, line 4);

a second database for storing the identification information for identifying the first

computer system, and system configuration information indicating the hardware components of

the first computer system (see column 10, lines 46-47, 61-65);

accepting means for accepting, from the first computer system, the identification

information of the first computer system (see column 10, lines 61-65);

first determining means for determining system configuration information which

corresponds to the accepted identification information, with reference to the second database (see

column 10, lines 61-65); and

sending means for sending the determined software components to the first computer

system (see column 10, line 37 – column 11, lines 17).

Beelitz also does not explicitly teach that the system configuration information associated

with the identification information indicates hardware components of the computer system, and

Beelitz does not explicitly teach the second determining means for determining the software

components required for operation of the hardware components indicated in the system

configuration information, with reference to the first database.

Amberg teaches a method for installing and testing software for a build-to-order

computer system where the system configuration information indicates hardware component of

the user's computer (see Fig 3B, item 370 and column 6, lines 33-40) and determining the

software components required for operation of the hardware components of the user's computer

system from the stored system configuration information, with reference to a database (see Fig 5,

steps 500-550 and column 8, lines 20-36, 50-57, column 9, lines 31-37, 46-52, and column 10,

lines 29-41; EN: the software installation steps associated with the hardware components in the

system descriptor record indicates the software that needs to be installed for the hardware

components of the system).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to have combined Beelitz with Amberg because Amberg further teaches that the system

descriptor record file disclosed in Beelitz (see column 10, lines 46-65 of Beelitz) indicates

hardware components of the user's computer and it is used to determine the software

components required for operation of the hardware components of the user's computer system to

facilitate easier customization of testing and software installation procedures for built-to-order

computer systems (see column 2, line 20-24, and column 3, lines 33-39 of Amberg).

21.   As per claim 11, the limitations recited in this claim are substantially similar to claim 3.

Therefore, it is rejected using the same reasons as claim 3.

22.   As per claim 16, the limitations recited in this claim are substantially similar to claim 8.

Therefore, it is rejected using the same reasons as claim 8.

23.   As per claim 17, Beelitz further teaches that the software component is a device driver

and the hardware component is a peripheral device of the user's computer system (see Fig 1,

items 14, 20, and column 3, lines 52-63).

24.   As per claims 18-23, the limitations recited in each of these claims are substantially

similar to claim 17. Therefore, they are rejected using the same reasons as claim 17.

Response to Remarks

25.   Applicant's remarks with respect to claims 1-8, 11, 16-23 have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

26.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

- o   O'Connor (US 5,894,571) is cited to teach a process for configuring software in a build-

  to-order computer system.

- o   Nguyen et al. (US 6,202,07 B1) is cited to teach a computer manufacturing system

  architecture with enhanced distribution functions.

- o   Doran et al. (US 6,385,766 B1) is cited to teach a method and apparatus for windows-

  based installation for installing software on build-to-order computer systems.

- o   Smith et al. (US 6,487,522 B1) is cited to teach a system and method for selectively

  executing a computer program based on the presence of associated hardware.

- o   Colligan et al. (US 6,519,762 B1) is cited to teach a method and apparatus for restoration

  of a computer system hard drive.

- o   Fogarty et al. (US 6,721,946 B1) is cited to teach a method and system for installing

  software on a computer in a computer manufacturing facility with particular application

  in a build-to-order computer manufacturing facility.

- o   Whiteside et al. (US 6,829,732 B2) is cited to teach network-based software recovery for

  build-to-order computer systems.

- o   Amro et al. (US 6,948,169) B1 is cited to teach web-based factory manufacturing of

  computers in a build-to-order manufacturing environment.

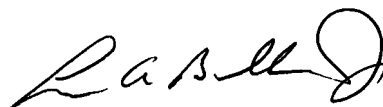- o   Toh et al. (US 7,188,255 B1) is cited to teach a software delivery system.

27.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jue S. Wang whose telephone number is (571) 270-1655. The

examiner can normally be reached on M-Th 7:30 am - 5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Meng-Ai An can be reached on 571-272-3756. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jue Wang
Examiner
Art Unit 2193

LEWIS A. BULLOCK, JR.
PRIMARY EXAMINER